



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/470,571	06/06/95	HARVEY J	5634.261

Hunton & Williams
1900 K Street, N.W.
Washington DC 20006-1109

LMC1/0608

EXAMINER

LUTHER, W

ART UNIT PAPER NUMBER

2731

DATE MAILED: 06/08/00 ²⁸

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 2731

1. The reply filed on 6/7/2000 (paper no 27)(27), is not fully responsive to the prior Office action because, *inter alia*, applicants have failed to address the most important issues for Section 112's written description requirement.

A. The record is more than clear by applicants' own remarks that their action to "incorporate-by-reference" "in its entirety" (attachment 1) was their **chosen vehicle** to get paper 21 (of parent 08/113,329) into the four corners of the instant disclosure, even though 27 apparently alleges it was "an accident" to include everything else such as the '81 case. However, 27 didn't identify what authority allows applicants to now delete paper 21 from the instant disclosure, and also as a consequence cause the deletion of the '81 case, and other accidentally included documents.

B. With respect to Section 112's written description requirement, Tom Scott has previously alleged Section 112's written description requirement is satisfied when:

- 1) instant claims are supported by the earlier '81 *disclosure*; and
- 2) instant claims are supported by the later *instant disclosure* (excluding that 08/113,329 'in its entity' added '81 case) (hereinafter referenced to as "test 1").

(i.e. in test 1, the subject matter of 1) does **not** have to be the same as 2))

(i.e. if any subject matter whatsoever in the '81 case can support instant claims; and

Art Unit: 2731

if any subject matter whatsoever in the *instant disclosure* (excepting the in it's entirely preliminary Amendment A incorporation by reference of the '81 case), then the written description requirement is satisfied)(i.e. 1) and 2) can be different).

Alternatively, examiner believes Section 112's written description requirement can **only** be satisfied with **intersecting** disclosure of the '81 case and the *instant disclosure* (excluding that '81 case incorporated by reference in the preliminary Amendment A).

For example, examiner believes the written description requirement is only satisfied if the following test can be performed successfully:

- 1) first, establish what subject matter is **common** to the '81 disclosure and the *instant specification's 557 pages and corresponding figures* (i.e. excluding the '81 case incorporated by reference by preliminary Amendment A); and
- 2) second, demonstrate that the intersecting subject matter, **alone**, fully supports the instant claims. (Hereinafter referred to as "test 2").

Applicants are requested to clarify whether they now believe that test 2 must necessarily be met in order to satisfy Section 112's written description requirement; or, whether they still believe test 1 is all that is required.

C. Last, how does citing sentences, passages, and paragraphs that **do not exist** in the instant disclosure (excepting the lately incorporated by reference '81 case by Amendment A) satisfying test 2? Note: 27 fails to reconcile the *alleged pending claim support* so, for that reason alone, 27

Art Unit: 2731

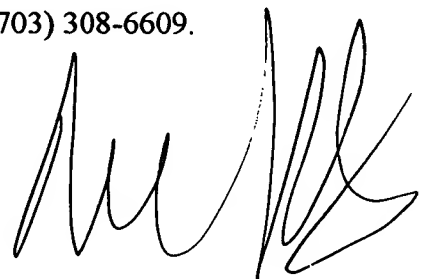
is found non-responsive. However, a satisfactory explanation for C can help examiner better understand ~~why~~ applicants have failed to reconcile *the alleged pending claim support*.

Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Luther whose telephone number is (703) 308-6609.

William Luther
Primary Examiner
June 9, 2000

A handwritten signature in black ink, appearing to be 'W. Luther', written in a cursive style.